**REMARKS**

This Response is submitted in reply to the Office Action dated May 30, 2006, issued in connection with the above-identified application. Claims 1-4 and 6-11 are pending in the application. With this Response, claims 1, and 6 have been amended. No new matter has been introduced as a result of the amendments made to the claims. Entry and favorable reconsideration are respectfully requested.

**I.  Response To §112 Rejections**

Claim 1 stands rejected under §35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. Specifically, claim 1 is rejected because the element "the network-externally valid connection destination" lacks proper antecedent basis. Accordingly, the Applicant has herein amended independent claim 1 to overcome the §112 rejection and respectfully requests that the rejection be withdrawn.

**II.  Response To §102 Rejections**

Claims 1-4 were rejected under 35 U.S.C. §102(e) as being anticipated by *Edholm* (U.S. Patent No. 6,772,210, hereafter "*Edholm*"). Claim 11 stands rejected under 35 U.S.C. §102(e) as being anticipated by Feinberg (U.S. Patent No. 6,798,745 hereafter "Feinberg"). The Applicant respectfully traverses the §102 rejections for the following reasons.

Based on a detailed review of *Edholm*, Applicants maintain that the reference fails to disclose a method for establishing a connection from a network-internal terminal of a packet-based communication network to a network-external connection destination, wherein the gateway device simulates to the connection controller that it is the destination and hides the relying of the connection from the connection controller.

As argued previously, the gatekeeper in *Edholm* does not simulate or determine the gateway as the destination i.e., endpoint of the connection. To the contrary, the gatekeeper in *Edholm* knows about the fact that the gateway is not the endpoint of the connection. Second, Edom gives no hint that the gateway actively hides the relaying of the connection from the gatekeeper. Rather, *Edholm* indicates that the gatekeeper knows about the relaying of the

connection and about the actual network-external endpoint of the connection. (see, *Edholm*, col. 4, lines 61-66; col. 5, lines 39-41, 58-62; and col. 9, lines 37-43).

The Applicant also respectfully points out that *Edholm* fails to disclose other features previously recited in claim 1.

For example, the "public network address or address/port number for the called VoIP device" of *Edholm* is not a network-externally valid transport address, as claimed. In claim 1, the terms "network-external" and "network-internal" refer to the packet-based communications network. "Network-internal" refers to the inside of that network and "network-external" refers to the outside of that network. According to claim 1, the calling terminal and the connection controller (gatekeeper) are "network-internal". Hence, a network-externally valid transport address has to be a valid transport address outside the network containing the calling terminal and the connection controller (gatekeeper).

To the contrary, in *Edholm* the calling VoIP device and the gatekeeper belong to the public network 104, not to the private network 108. (see, *Edholm*, Fig. 1). Therefore, it is the public network to which the term network-internal refers. To this end, a network-externally valid transport address has to be a valid transport address outside that public network (i.e., within the private network 108). However, as the public network address of *Edholm* is a valid transport address within the public network but not outside the public network (i.e., within the private network), it can not be identified with a network-externally valid transport address, as claimed.

*Edholm* does not disclose that the gateway allocates the network-externally valid transport address to the transmitted logical address information. The Examiner identified the logical address information with the phone number of the called VoIP device 110 and the network-externally valid transport address with the public network address or address/port number pair for the called VoIP device 110. However, the public network address is not allocated to that phone number by the gateway. Rather, the gateway allocates the public network address to the private network address of the called VoIP device. Additionally, the private network address of the called VoIP device is not identical to the phone number of the called VoIP device. The private network address is only usable within the private network, i.e., not within the public network where the phone number is obviously usable. (see, *Edholm*, col. 4, lines 22-26).

### III.     Rebuttal of Examiner's Response to Arguments:

<u>Claim 1</u>

Applicants notes that FIG. 2a (col. 5, lines 27- 62) and FIG. 2b (col. 5, line 63 to col. 6, line 32) of *Edholm* describe two separate and distinct embodiments, which are not functionally correlated to one another.

In the second embodiment of *Edholm*, relied upon in the Office Action (FIG. 2b - col. 5, line 63 to col. 6, line 32), the calling VoIP device (102, 110) sends a request to the gatekeeper 112. The gatekeeper 112 sends a response to the calling VoIP device that includes a gateway address. Upon receiving that response, the calling VoIP device sends a request 233 to the gateway 106 requesting the network address for the called VoIP device. The gateway 106 then determines the requested network address and sends this address to the VoIP device. This contrasts from the first embodiment (FIG. 2a col. 5, lines 27- 62), where a request to the gatekeeper 112, prompts a request 212 to the gateway 106 for a network address for the called VoIP device. The gateway 106 then determines the requested network address and sends this address to the gatekeeper, which in turn relays that address to the calling VoIP device. Thus, in Fig. 2b, the *calling VoIP device*, and not the gatekeeper, requests the network address of the called VoIP device directly from the gateway.

Nevertheless, both embodiments clearly demonstrate that the gatekeeper does <u>not</u> resolve by itself the address <u>of the called VoIP device</u>. Instead, the address of the connection destination is determined or resolved by the gateway. The gatekeeper only determines, by itself, the address of the gateway alone.

In the embodiment of FIG. 2a, the gatekeeper is configured such that the gateway can not be the destination of the connection. Otherwise, the gatekeeper would not need or request a further address resolution and simply connect the calling VoIP device with the gateway. Accordingly, the gateway in FIG. 2a neither simulates the gatekeeper to be the destination of the connection nor hides the connection from the gatekeeper. The Office Action states that the gateway would hide the relaying of the connection from the gatekeeper, since the gatekeeper would only interact with the called device through the gateway (page 12). However this is incorrect. Under this logic, one could "proof" that the gateway hides the relaying of <u>any</u>

connection from a calling VoIP device which has to interact with a called device via the gateway. However, this is not how gateways operate, and certainly not what *Edholm* discloses for the reasons given above.

In the embodiment of FIG. 2b, the Office Action concedes that the gatekeeper is not part of the connection process after responding to the initial request of the calling VoIP device. Thus there can be <u>no</u> interaction between the gateway and the gatekeeper at all. Accordingly, FIG. 2b cannot teach or suggest show the claimed feature of "establishing a connection <u>controlled by the connection controller</u> between the terminal and the gateway device". Moreover, since the gateway lacks any interaction with the gatekeeper, it also cannot simulate to the gatekeeper that it is the connection destination.

Applicant notes that the above embodiments describe two separate and distinct embodiments, which are not functionally correlated to one another. To combine features of these separate embodiments would run counter to the teaching in the reference and would be improper to apply to the present claims.

Applicants also add that the fact that a phone number (i.e., logical address information) of the called VoIP device is needed, before the gateway can determine the public address of the called VoIP device, does not mean that the determined public address is <u>assigned</u> to the transmitted phone number, as claimed in claim 1. After the determination of the public address, the phone number is no longer needed and is typically discarded. *Edholm* provides no contrary teaching in this regard.

Claim 11

Regarding claim 11, the claim is directed to a first packet-switched interface that is an interface to a gatekeeper-controlled communication network. Conversely, Feinberg does not disclose two packet-switched interfaces to different networks. Although the Examiner relies on the gatekeeper 108 as the first packet-switched, Feinberg does not specify that that connection between the gateway 108 and the gatekeeper 108 is via a network different from the packet network 110. Additionally, Feinberg does not disclose a second interface conforming to the ITU H.323 mode and being designed for simultaneous operation in a non-gatekeeper H.323 mode. Feinberg only discloses that the communication between the gateway and the gatekeeper (i.e.,

the communication which is related to the first interface by the examiner) can use H.323. Feinberg gives no suggestion that a second interface of the gateway leading to the packet network 110 would conform to H.323.

Moreover, a non-gatekeeper H.323 mode is a specific mode defined in the 1TU recommendation H.323. Hence, the non-gatekeeper H.323 mode of claim 11 can not be identified with an environment that simply lacks a gatekeeper. Feinberg gives no suggestion why the (second) interface to the non-interacting network should operate in a (non-gatekeeper) H.323 mode. However, if in contrast the packet network 110 did interact with the gatekeeper 108, then Feinberg teaches away from a packet network 110 in a non-gatekeeper (H.323) mode.

Regarding the Examiner's Response, the arguments fail to appreciate that different communication networks are being utilized. The claim language of claim 11 clearly discloses a "gatekeeper-controlled communication network" and a "further communication network." Feinberg fails to teach or suggest a gateway with a first packet-switched interface to a first communications network, and a second packet-switched interface to a further communications network.

The assertion stating that "since the second interface is part of the gateway 106 and gateway 106 uses the H.323 protocol, the second interface also conforms to the H.323 protocol" is simply not correct. Under this logic, the interface of the Gateway 106 to the PSTN network 104 (see figure 1) would also have to conform to the H.323 protocol. However, the PSTN 104 is a circuit switched network, which has nothing to do with the packed based standard H.323.

Also, the assertion that "the connection between gateway 106 and packet network 110 is non-gatekeeper H.323 mode since it does not interact with the gatekeeper 108" is also incorrect. FIG. 1 clearly shows an interaction between the gatekeeper 108 and the packet network 110. As the Office Action asserts that the interface of the gateway 106 to the network 110 (which interacts with the gatekeeper) conforms to H.323, there is no teaching that explains why this interface should be designed for operation in a non-gatekeeper H.323 mode. In particular, the disclosure of Feinberg teaches that the gatekeeper 108 and the network 110 are connected to the gateway 106 via the same interface 206 (see e.g. FIG. 2, col. 4, line 64 - col. 5, line 3). However, there are no first and second H.323 conforming interfaces as required by the present claims.

Accordingly, independent claim 1 is believed to be clearly distinguishable over *Edholm*. Likewise, dependent claims 2-4 are also believed to be distinguishable over *Edholm* at least based on their dependency from independent claim 1. Furthermore, the Applicant respectfully submits that claim 11 is clearly distinguishable over Feinberg for at least the reasons noted above.

IV.     **Response To §103 Rejections**

Claims 6-10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Thornton* (US Patent 6,363,065, hereafter "*Thornton*") in view of *Edholm*. The Applicant respectfully traverses the §103 rejections for the following reasons.

The present invention as recited in independent claim 6 (as amended) is directed to a method for establishing a connection from a network-internal terminal of a packet-based communication network to a network-external connection destination, wherein the gateway device simulates to the connection controller that it is the destination and hides the relying of the connection from the connection controller.

Neither, *Edholm* nor *Thornton* teach or suggest that a gateway simulates as a destination or hides the relaying of a connection from the gatekeeper. To the contrary, *Edholm* (see, *Edholm*, col. 4, lines 61-66; col. 5, lines 39-41, 58-62; col. 9, lines 37-43) and *Thornton* (see, *Thornton*, col. 55, lines 44-52) disclose that the gatekeeper knows about the relaying of the connection. Therefore, even if one of ordinary skill in the art were to combine the teachings of *Thornton* and *Edholm*, the combination still would not teach or suggest all the features as recited in claim 6. (as amended).

Furthermore, the Applicant submits that there is no teaching, suggestion or motivation for one of ordinary skill in the art to combine the teachings of the *Thornton* and *Edholm* in the manner suggested by the Examiner. *Thornton* is directed to providing VoIP services and QoS improvements to PSTN users utilizing VoIP technologies. (See, *Thornton*, Abstract). In contrast, *Edholm* is wholly silent regarding the use of PSTN system, and makes no provisions whatsoever for their use, and relies exclusively on an IP communications network. The Office Action stated that "[b]y modifying *Thornton* et al to include that the logical address information (called number) represents the network-internal connection destination (gateway) and the external

connection destination (called device), the <u>gatekeeper</u> can route calls both within and <u>outside</u> the network" (emphasis added). However, this motivation does not represent the teaching in *Edholm* and *Thornton*, and runs contrary to the claimed features that require that the gateway *simulates* the connection controller (gatekeeper) to be the connection destination and hides the relaying of the connection from the connection controller (gatekeeper). This configuration significantly reduces the involvement of the gatekeeper to handle or even know about connections outside of its own network, since the gatekeeper would otherwise be required to handle a much more complicated protocol that would defeat the purpose of the present claims. Furthermore, if the gatekeeper had to route calls outside its network in the manner suggested in the Office Action, then the gateway would not *simulate* the connection destination nor hide the relaying of the connection to the gatekeeper. As such, there is no teaching, suggestion or motivation for one having ordinary skill in the art to combine these references, and arrive at the present invention.

Accordingly, independent claim 6 is clearly distinguishable over *Thornton* and *Edholm*, individually or in combination, for at least the reasons noted above. Likewise, claims 7-10 are also believed to be distinguishable over *Thornton* and *Edholm*, individually or in combination, at least based on their dependency from independent claim 6.

## IV.    Conclusion

In light of the above, the Applicant respectfully submits that claims 1-4 and 6-11 are both novel and non-obvious over the art of record.  The Applicant respectfully requests that a timely Notice of Allowance be issued in this case.  A petition for a one-month extension of time also accompanies this Response.  If any additional fees are due in connection with this application as a whole, the Examiner is authorized to deduct such fees from deposit account no. 02-1818.  If such a deduction is made, please indicate the attorney docket no. (0112740-311) on the account statement.

Respectfully submitted,

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